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**IN THE UNITED STATES DISTRICT COURT  
FOR THE CENTRAL DISTRICT OF CALIFORNIA**

DMF, Inc., a California corporation,  
Plaintiff,

v.

AMP Plus, Inc. d/b/a ELCO Lighting,  
a California corporation; and

ELCO Lighting Inc., a California  
corporation,

Defendants.

Civil Action No. 2:18-cv-07090 CAS  
(GJXx)

**Plaintiff DMF's Motion for Partial  
Summary Judgment**

Date: March 2, 2020  
Time: 10:00 a.m.  
Ctmm: 350 W. First. Street,  
Room 8D

Hon. Christina A. Snyder

**REDACTED - CONFIDENTIAL  
PURSUANT TO PROTECTIVE ORDER**

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**I. Introduction**

The Court should grant summary judgment finding infringement and validity of DMF's U.S. Patent No. 9,964,266 ("the '266 Patent"). The Court already has essentially resolved the infringement issues in this case by ruling on Defendants' ("ELCO's") numerous claim construction arguments, clearing the way for a determination of infringement based on undisputed facts regarding the structure and operation of ELCO's ELL Modules. The Court also should grant summary judgment that the asserted patent claims are not invalid. ELCO argues that the patent claims are "anticipated" but lacks a single prior art reference disclosing each claim limitation. ELCO relies on an expert's conclusory opinions, which ignored the teaching of the prior art references and suggested a modification of the prior art that would have resulted in a risk of electrocution—the opposite of what the prior art intended. Finally, the Court should grant summary judgment on ELCO's "unclean hands" defense because DMF did not engage in any unconscionable act to obtain or enforce its patent. ELCO's defense is based on DMF's short-hand reference to a UL-standard that was approved by UL, and that ELCO itself also used on an identical product.

**II. Legal Standards**

Summary judgment is appropriate where "there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law."<sup>1</sup> The moving party bears the initial burden of identifying relevant portions of the record that demonstrate the absence of a fact or facts necessary for one or more essential elements of each claim upon which the moving party seeks judgment.<sup>2</sup>

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<sup>1</sup> Fed. R. Civ. P. 56(a).

<sup>2</sup> See *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986).

1 If the moving party meets its initial burden, the opposing party must then set  
2 out specific facts showing a genuine issue for trial in order to defeat the motion.<sup>3</sup>  
3 The nonmoving party must not simply rely on the pleadings and must do more than  
4 make “conclusory allegations [in] an affidavit.”<sup>4</sup> Summary judgment must be  
5 granted for the moving party if the nonmoving party “fails to make a showing  
6 sufficient to establish the existence of an element essential to that party’s case, and  
7 on which that party will bear the burden of proof at trial.”<sup>5</sup>

8 In light of the facts presented by the nonmoving party, along with any  
9 undisputed facts, the Court must decide whether the moving party is entitled to  
10 judgment as a matter of law.<sup>6</sup> When deciding a motion for summary judgment, “the  
11 inferences to be drawn from the underlying facts . . . must be viewed in the light  
12 most favorable to the party opposing the motion.”<sup>7</sup> Summary judgment for the  
13 moving party is proper when a rational trier of fact would not be able to find for the  
14 nonmoving party on the claims at issue.<sup>8</sup>

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21 <sup>3</sup> *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250, 106 S. Ct. 2505, 91 L. Ed.  
22 2d 202 (1986); *see also* Fed. R. Civ. P. 56(c), (e).

23 <sup>4</sup> *Lujan v. Nat'l Wildlife Fed'n*, 497 U.S. 871, 888, 110 S. Ct. 3177, 111 L. Ed. 2d  
695 (1990); *see also* *Celotex*, 477 U.S. at 324.

24 <sup>5</sup> *Celotex* at 322; *see also* *Abromson v. Am. Pac. Corp.*, 114 F.3d 898, 902 (9th  
Cir. 1997).

25 <sup>6</sup> *See T.W. Elec. Serv., Inc. v. Pac. Elec. Contractors Ass'n*, 809 F.2d 626, 631,  
n.3 (9th Cir. 1987).

26 <sup>7</sup> *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587, 106 S.  
27 Ct. 1348, 89 L. Ed. 2d 538 (1986) (citation omitted); *Valley Nat'l Bank of Ariz. v.*  
*A.E. Rouse & Co.*, 121 F.3d 1332, 1335 (9th Cir. 1997).

28 <sup>8</sup> *See Matsushita*, 475 U.S. at 587.

### III. ELCO Infringed The ‘266 Patent

An infringement analysis has two steps.<sup>9</sup> First, the court construes the asserted claims.<sup>10</sup> Second, the court determines whether the accused product meets each element of the claim as construed.<sup>11</sup>

Here, as to the first step, the Court construed the claims on August 2, 2019, after receiving briefs and evidence from the parties and conducting a *Markman* hearing on July 29, 2019.<sup>12</sup> As to step two, “[a]n accused product infringes a claim if it embodies each claim element or its equivalent.”<sup>13</sup> The patentee must prove infringement by a preponderance of the evidence.<sup>14</sup>

“The addition of features does not avoid infringement, if all the elements of the patent claims have been adopted.”<sup>15</sup> That is because “any other reasoning would allow an infringer to avoid infringement merely by adding additional elements to an infringing device.”<sup>16</sup>

In this case, DMF asserts that three versions of ELCO’s ELL Modules (Version 1, 2 and 3) infringe the following claims of the ‘266 Patent:

- Independent Claim 1 and its dependent Claims 2, 4-8 and 13-16.
- Claims 19 and 21 that depend from Independent Claim 17
- Claim 25 that depends from Independent Claim 22.
- Independent Claim 26 and its dependent Claims 28-30.

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<sup>9</sup> *Indivior Inc. v. Dr. Reddy's Labs., S.A.*, 930 F.3d 1325, 1336 (Fed. Cir. 2019)(citing *Clare v. Chrysler Grp. LLC*, 819 F.3d 1323, 1326 (Fed. Cir. 2016)).

<sup>10</sup> *Indivior*, 930 F.3d. at 1336.

<sup>11</sup> *Indivior* at 1336.

<sup>12</sup> Dkt. 266.

<sup>13</sup> *TEK Glob., S.R.L. v. Sealant Sys. Int'l*, 920 F.3d 777, 784 (Fed. Cir. 2019).

<sup>14</sup> *Siemens Med. Sols. USA, Inc. v. Saint-Gobain Ceramics & Plastics, Inc.*, 637 F.3d 1269, 1279 (Fed. Cir. 2011).

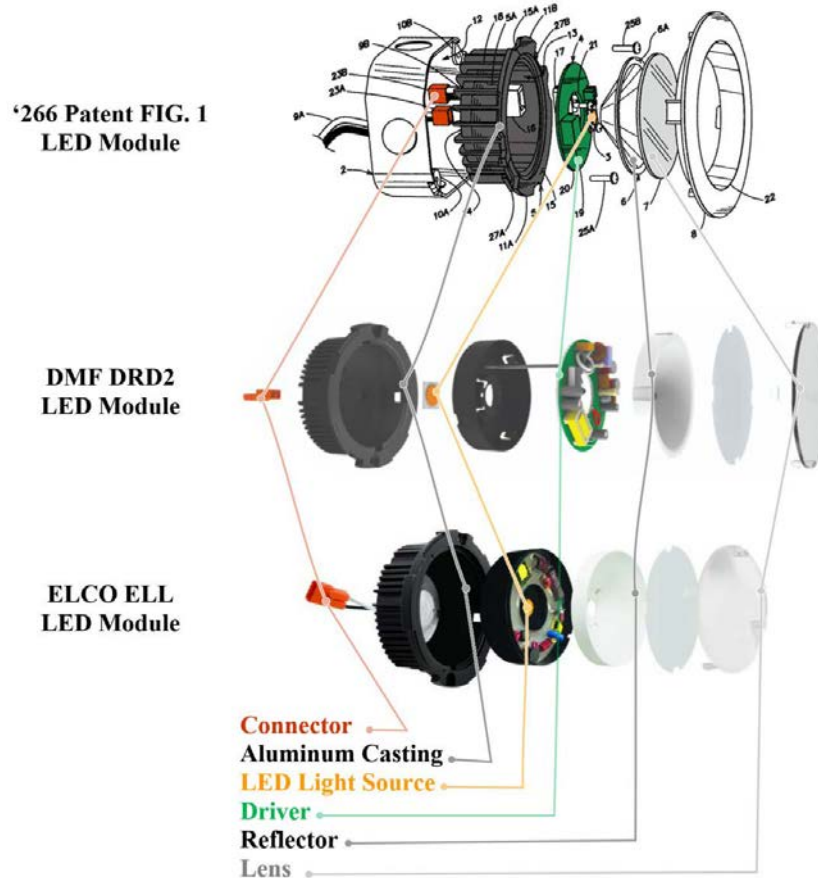
<sup>15</sup> *N. Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 945 (Fed. Cir. 1990).

<sup>16</sup> *Suntiger, Inc. v. Sci. Research Funding Grp.*, 189 F.3d 1327, 1336 (Fed. Cir. 1999).

Below, from left to right, are images of accused Version 1, Version 2 (which is Version 1 with a metal cap on top) and Version 3 (which has a casting extended in a conical shape like the cap on Version 2):<sup>17</sup>



The accused ELCO ELL Modules are copies of DMF's DRD2 Module that practices the invention claimed in the '266 Patent. Below is an image from the Complaint (Dkt. 1) that compares the '266 Patent Figure 1, DMR DRD2 Module and ELCO Version 1 ELL Module:<sup>18</sup>

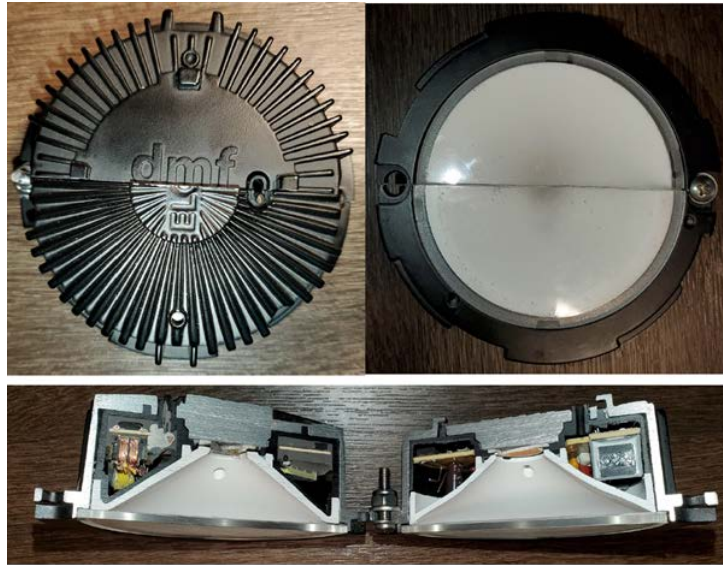


<sup>17</sup> SUF 3.

<sup>18</sup> Benya Dec. ¶165.



Shown below are images of one-half of DMF's DRD2 Module next to one-half of Version 1 of the ELCO ELL Module:<sup>19</sup>



Below are images of one-half of a Version 2 and one-half of a Version 3 ELCO ELL Module next to each other, where the internal view provided at the bottom further illustrates the similarity with Version 1 (the left side shows the Version 1 module with an aluminum cylinder and black conical cap placed on top to make the Version 2):<sup>20</sup>



Because the ELCO ELL Modules were copied from DMF's patent DRD2 product, there is little dispute that the ELCO's product infringe the '266 Patent.<sup>21</sup>

<sup>19</sup> SUF 5.

<sup>20</sup> SUF5SUF 7.

<sup>21</sup> SUF 171-197.



1 The Court’s claim construction ruling, by design, resolved the primary infringement  
2 disputes concerning all three versions of the ELCO ELL Modules—e.g., “closed rear  
3 face”, “significantly dissipate heat” and “substantially heat conducting.”

4 The Statement of Undisputed Facts (“SUF”) submitted currently herewith,  
5 therefore, show in SUF 1 through SUF 93 that there is no genuine dispute of  
6 material fact that each limitation of the asserted patent claims are met by all three  
7 versions of ELCO’s ELL Modules (Version 1, 2 and 3) in view of the Court’s claim  
8 construction ruling.

#### 9 **IV. The ‘266 Patent Claims Are Not Invalid**

10 ELCO’s prior art invalidity challenges are premised on three references that  
11 the Court considered in the preliminary injunction motion and found to have little  
12 merit:

- 13 • Imtra low-voltage boat lights.
- 14 • Kim reference with a two-part housing that is identical to the Woo  
15 Reference expressly considered and the asserted claims allowed over  
16 during prosecution of the ‘266 Patent
- 17 • LMH2 reference that is a low-voltage device having an external driver and  
18 heat sink.

19 The Court’s claim construction ruling, by design, resolved the primary validity  
20 disputes—e.g., “driver”, “standard junction box” and “unified casting”. Accordingly,  
21 SUF 94 through 167 show there is no genuine issue of material fact that the asserted  
22 patent claims are not invalid.

#### 23 **A. Invalidity Standard**

24 Under 35 U.S.C. § 282, patents are presumed to be valid. Overcoming this  
25 presumption requires clear and convincing evidence.<sup>22</sup>

#### 26 **1. Anticipation**

27 A party may show that a patent claim is invalid is by showing that the patent  
28 claim was anticipated by alleged prior art.<sup>23</sup> A party asserting that a patent claim

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<sup>22</sup> *Microsoft Corp. v. i4i Ltd.*, 131 S. Ct. 2238, 2243, 180 L. Ed. 2d 131 (2011).

<sup>23</sup> 35 U.S.C. §102.

1 was anticipated must show that a single prior art reference disclosed every claim  
2 limitation arranged or combined in the same way as recited in the patent claim.<sup>24</sup>

3 The requirement that the prior art elements themselves be “arranged as in the  
4 claim” means that claims cannot be “treated . . . as mere catalogs of separate parts, in  
5 disregard of the part-to-part relationships set forth in the claims and that give the  
6 claims their meaning.”<sup>25</sup>

## 7 **2. Obviousness**

8 A party may show that a patent claim is invalid is by showing that the patent  
9 claim would have been obvious in view of alleged prior art.<sup>26</sup> A party asserting that  
10 a patent claim would have been obvious in light of prior art must show that the  
11 differences between the patent claim and the prior art are such that the claimed  
12 invention as a whole would have been obvious before the effective filing date of the  
13 patent claim to a person having ordinary skill in the art to which the claimed  
14 invention pertains.<sup>27</sup>

15 Obviousness is a question of law with underlying factual findings relating to  
16 the scope and content of the prior art; differences between the prior art and the  
17 claims at issue; the level of ordinary skill in the pertinent art; the presence or absence  
18 of a motivation to combine or modify with a reasonable expectation of success; and  
19 any objective indicia of non-obviousness.<sup>28</sup>

20 A party asserting that a patent claim would have been obvious—ELCO here—  
21 must show that a person of ordinary skill at the time of the invention would have

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22 <sup>24</sup> *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1325, 1332-33 (Fed. Cir. 2010);  
23 *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

24 <sup>25</sup> *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d  
25 1452, 1459 (Fed. Cir. 1984).

26 <sup>26</sup> 35 U.S.C. § 103(a).

27 <sup>27</sup> *Id.*; *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406, 127 S. Ct. 1727, 1734  
(2007).

28 <sup>28</sup> *Persion Pharm. LLC v. Alvogen Malta Operations LTD.*, 945 F.3d 1184 (Fed.  
Cir. 2019); *KSR*, 550 U.S. at 406.

1 selected, combined prior art elements in different references in the normal course of  
2 research and development to yield the claimed invention.”<sup>29</sup> To render a  
3 claim obvious, prior art cannot be “vague” and must collectively, although not  
4 explicitly, guide an artisan of ordinary skill towards a particular solution.<sup>30</sup>

5 In pursuing obviousness grounds, the party must not use hindsight where the  
6 challenged patent is being used as a template to guide the party to pick-and-choose  
7 references to combine.<sup>31</sup> The reason for combining different prior art references is a  
8 critical component of an obviousness analysis, requiring a party challenging the  
9 validity of a patent claim as obvious to provide an explicit analysis of the prior art  
10 motivation to combine references.<sup>32</sup>

11 Objective evidence of nonobviousness such as industry praise or copying is a  
12 fundamental part of the overall obviousness analysis that should be considered.<sup>33</sup>  
13 Such evidence plays an important role as a guard against prohibited hindsight and  
14 may often be the most probative and cogent evidence in the record.<sup>34</sup>

15 Objective evidence of nonobviousness includes whether others in the industry  
16 have copied the claimed invention and whether the claimed invention has received

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18 <sup>29</sup> *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360-61 (Fed. Cir.  
19 2011)(citing *KSR*, 550 U.S. at 421).

20 <sup>30</sup> *Id.*

21 <sup>31</sup> *KSR*, 550 U.S. at 421 (“A factfinder should be aware . . . of the distortion  
22 caused by hindsight bias and must be cautious of arguments reliant upon *ex*  
23 *post* reasoning.”); *Graham*, 383 U.S. at 36 (cautioning that courts must not “slip[]  
24 into use of hindsight”); *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“It is  
25 impermissible to use the claimed invention as an instruction manual or ‘template’ to  
26 piece together the teachings of the prior art so that the claimed invention is  
27 rendered obvious.”).

28 <sup>32</sup> *KSR*, 550 at 398 (analysis of reason to combine the known elements in the  
fashion claimed by the patent should be made explicit); *see also Innogenetics v.*  
*Abbott Labs*, 512 F.3d 1363, 1373-74 (Fed Cir. 2008)( “Knowledge of a problem  
and motivation to solve it” are insufficient to show “motivation to combine  
particular references to reach the particular claimed method.”)

<sup>33</sup> *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1378 (Fed. Cir. 2012).

<sup>34</sup> *Id.*

1 industry praise.<sup>35</sup> Evidence that the industry praised a claimed invention or a product  
2 which embodies the patent claims weighs against an assertion that the same claim  
3 would have been obvious because industry participants are not likely  
4 to praise an obvious advance over the known art.<sup>36</sup>

5 Objective considerations such as industry praise and copying help turn back  
6 the clock and place the claims in the context that led to their invention because  
7 technical advance often occurs through incremental steps that, in retrospect, may  
8 seem deceptively simple.<sup>37</sup> Often the inventive contribution lies in defining the  
9 problem in a new revelatory way.<sup>38</sup> The Federal Circuit requires consideration of  
10 these objective indicia because they “provide objective evidence of how the patented  
11 device is viewed in the marketplace, by those directly interested in the  
12 product.”<sup>39</sup> There should be a nexus between the claimed invention and objective  
13 evidence of nonobviousness.<sup>40</sup> There is a presumption of nexus for objective  
14 considerations when the objective evidence is tied to a specific product and that  
15

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16  
17 <sup>35</sup> *Crocs, Inc. v. ITC*, 598 F.3d 1294, 1311 (Fed. Cir. 2010) (“Copying may indeed  
18 be another form of flattering praise for inventive features. In the absence of any  
19 record evidence attributing these secondary considerations to causes other than the  
20 claimed invention, [patentee] may rely on this added support for non-obviousness.”)

21 <sup>36</sup> *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1334 (Fed. Cir. 2016).

22 <sup>37</sup> *Mintz*, 679 F.3d at 1378.

23 <sup>38</sup> *Id.* at 1377.

24 <sup>39</sup> *Mintz*, 679 F.3d at 1378-79 (citing *Demaco Corp. v. F. Von Langsdorff*  
25 *Licensing Ltd.*, 851 F.2d 1387, 1391 (Fed. Cir. 1988)); *see also Spectralytics, Inc. v.*  
26 *Cordis Corp.*, 649 F.3d 1336, 1344 (Fed. Cir. 2011) (“The objective considerations  
27 reflect the contemporary view of the invention by competitors and the  
28 marketplace.”); *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264,  
1273 (Fed. Cir. 1991) (“The significance of a new structure is often better measured  
in the marketplace than in the courtroom.”); *Interconnect Planning Corp. v. Feil*,  
774 F.2d 1132, 1143 [\*\*\*1902] (Fed. Cir. 1985) (“Recognizing the difficulty of  
casting one’s mind back to the state of technology at the time the invention was  
made, courts have long recognized the usefulness of evidence of the  
contemporaneous attitude toward the asserted invention. A retrospective view of the  
invention is best gleaned from those who were there at the time.”)

<sup>40</sup> *WBIP*, 829 F.3d at 1329.

product “is the invention disclosed and claimed in the patent.”<sup>41</sup>

## A. Imtra

ELCO relies on two Imtra catalogs of marine boat lights and a physical Imtra Hatteras product as alleged prior art to the asserted patent claims:

- Imtra Marine Lighting Product Catalog (“Imtra 2011” Ex. 265 and 265-C)<sup>42</sup>
- Imtra Marine Lighting Product Catalog for Spring 2007 (“Imtra 2007 Ex. 317”)<sup>43</sup>
- Imtra Hatteras physical product<sup>44</sup>

Below are images from the Imtra 2011 catalog:<sup>45</sup>



<sup>41</sup> *Id.* at 1329 (quoting *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997)); see also *Crocs*, 598 F.3d at 1310-11.

<sup>42</sup> SUF 101-117.

<sup>43</sup> SUF 119-120.

<sup>44</sup> SUF 94-100.

<sup>45</sup> SUF 101.

None of the Imtra products was designed to mate with or be mounted to tabs of a standard junction box, so they lack the “plurality of elements” limitation required by all asserted patent claims.<sup>46</sup> As a result, the Imtra products cannot anticipate these claims. Below is an image provided by ELCO’s expert Dr. Bretschneider of an Imtra Hatteras product placed within the only standard junction box he identified with the tabs of the junction box and diameter of the Imtra Hatteras circled yellow showing Imtra Hatteras does not come close to having a “plurality of elements” to align with the tabs of the standard junction box.<sup>47</sup>



All of the Imtra products (except the Sardinia 120 VAC Family) are low-voltage devices that receive low-voltage DC, rather than building mains voltage.<sup>48</sup> So they additionally lack the “driver” required by all asserted claims.

#### **B. Kim Reference**

The Kim Reference is identical to the Woo Reference that two Patent Office Examiner’s found did not invalidate the asserted ‘266 Patent claims.<sup>49</sup> Below is an image of Kim and Woo showing a non-heat conducting housing (orange) with a heat

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<sup>46</sup> SUF94-117. SUF 96-98; SUF 106, 110.

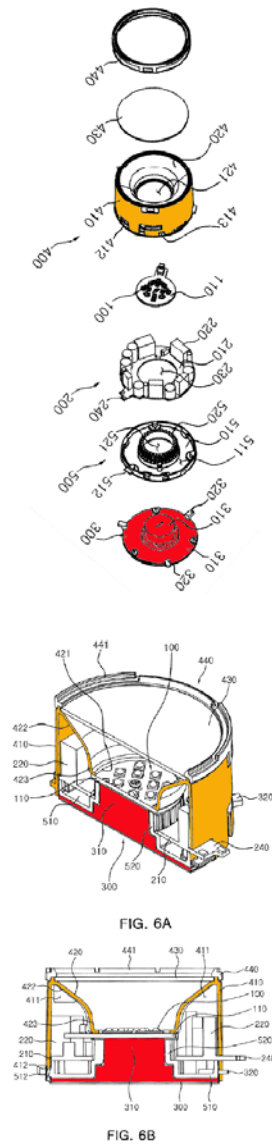
<sup>47</sup> SUF 98.

<sup>48</sup> SUF 95, 99, 108-109, 111-112

<sup>49</sup> SUF 145-151.



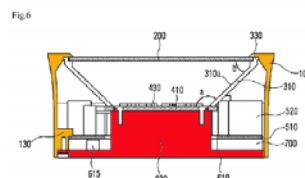
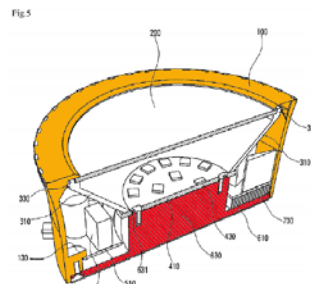
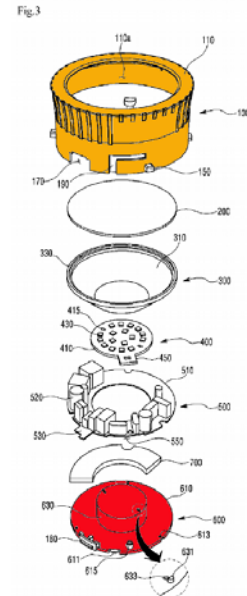
conducting heat sink (red) that does not meet the “unified casting” limitation required in all asserted patent claims:



Woo Reference

### C. LMH2 Reference

The LMH2 Reference is a low-voltage light source with an external driver and does not meet the “driver” limitation required in all asserted patent claims.<sup>50</sup> It requires an external heat sink and does not meet the “unified casting” limitation required by all asserted claims.<sup>51</sup> Further, the LMH2 light source has three equally



Kim Reference

<sup>50</sup> SUF 160, 163.

<sup>51</sup> SUF 161, 164, 167.

1 spaced holes along its perimeter that do not align with tabs of a standard junction  
2 box and, thus, does not have the “plurality of elements” limitation required by all  
3 claims.<sup>52</sup> Below is an image of the LMH2 light source and external driver:



#### 10 **D. Gifford**

11 Gifford has a safety adaptor apparatus 100 that is placed at the opening of a  
12 junction box to isolate the dangerous building mains voltage inside the junction box  
13 above the safety adaptor apparatus from the room below.<sup>53</sup> The safety adaptor  
14 apparatus is to safely attach surface mounted light fixtures to the adaptor. Below is  
15 an image of Gifford:

#### 17 **E. ELCO's Invalidity Grounds**

18 ELCO raises several invalidity grounds based on anticipation or obviousness.  
19 ELCO's anticipation arguments fail as a matter of law because ELCO has not  
20 identified a single prior art reference that meets the limitations of any claim arranged  
21 or combined as claimed.<sup>54</sup>

22 In addition, ELCO's obviousness arguments are based on a conclusory report  
23 from its expert, Eric Bretschneider, whose report did not explain how prior art  
24 references would be combined or what problems summarized above, the motivation  
25 would have been for these combinations.

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26 <sup>52</sup> SUF 162, 165-166.

27 <sup>53</sup> SUF 127-130.

28 <sup>54</sup> See generally SUF 94-167

1 Dr. Bretschneider's opinions regarding a motivation to combine references fail  
2 to create a triable fact issue regarding obviousness. One example of this is Dr.  
3 Bretschneider's opinion that a motivation to combine exists to modify the Kim  
4 reference and install it in a junction box because the "growing demand for energy  
5 efficient lighting devices would motivate a POSITA to modify Kim for installation  
6 in a junction box for use in a variety of in-demand installations and applications."<sup>55</sup>  
7 This generic argument is similar to an expert opinion that the Federal Circuit found  
8 insufficient in *ActiveVideo*, where the expert opined:

9 The motivation to combine would be because you wanted to build  
10 something better. You wanted a system that was more efficient, cheaper,  
11 or you wanted a system that had more features, makes it more attractive  
12 to your customers, because by combining these two things you could do  
something new that hadn't been able to do before.<sup>56</sup>

13 Such generic opinions bear no relation to any specific combination of prior art  
14 elements and fail to explain why a person of ordinary skill in the art would have  
15 combined elements from specific references in the way the claimed invention does.<sup>57</sup>

16 To the extent that Dr. Bretschneider provided any detail regarding a  
17 combination of references, it was to explain why he proposed modifying the Imtra  
18 low voltage boat light with the teachings of the Gifford patent.<sup>58</sup> Dr. Bretschneider  
19 admitted during his deposition that by combining Gifford with Imtra, his "modified  
20 Imtra would be connected directly to the junction box with no structure in  
21 between."<sup>59</sup> And he agreed that "when you install the ...modified Imtra product,  
22 when you're attaching it or removing it, the high voltage electrical power inside the  
23

24 <sup>55</sup> Davidson Ex. 491 at 80, ¶167.

25 <sup>56</sup> *ActiveVideo Networks, Inc. v. Verizon Communs., Inc.*, 694 F.3d 1312, 1327-28  
26 (Fed. Cir. 2012).

27 <sup>57</sup> *Id.*

28 <sup>58</sup> Davidson Ex. 491 at 78-79.

<sup>59</sup> Davidson Ex. 311 (January 21, 2020 Bretschneider Tr.) at 164.

1 junction box would be exposed to the person changing out that light fixture.”<sup>60</sup>

2       There is no genuine dispute that the objective of Gifford and its disclosure of  
3 an adaptor plate is to prevent the very risk of electrical shock that would exist with  
4 Dr. Bretschneider’s modified Imtra, which he claims to have based on the teachings  
5 of Gifford.<sup>61</sup> Dr. Bretschneider also testified that the actual goal of lighting  
6 designers is not just to reduce, but to eliminate the risk of electric shock.<sup>62</sup> Contrary  
7 to the teachings of Gifford itself, however, Dr. Bretschneider has used Gifford to  
8 remove the plate that serves to reduce the risk of shock, to propose a hindsight  
9 reconstruction of the patented invention.

10       Dr. Bretshneider also formed his opinion without considering the significant  
11 objective evidence of non-obviousness, including industry praise and copying by  
12 ELCO. Awards that DMF has received because of the DRD2 include the IES  
13 Progress Report award in 2016, in which the Illuminating Engineering Society (IES)  
14 selected DMF’s recessed lighting system based on “an impartial judging process  
15 used by the committee to evaluate each submission on its uniqueness, innovation and  
16 significance of the lighting industry.”<sup>63</sup> DMF’s OneFrame system with the DRD2  
17 inserted into a hanger junction box was selected based on benefits of the ‘266 Patent  
18 invention because, “[w]ith this unique design there’s no need for costly fire-boxing,  
19 eliminating the need to involve other trades for installation, reducing construction  
20 time, materials and cost.”<sup>64</sup> That award recognized one of the benefits that the  
21 applicant explained to the patent examiners who issued the ‘266 Patent, i.e., the  
22 inventor’s “assembly mitigates the labor-intensive construction of separate fire-

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25       <sup>60</sup> Davidson Ex. 311 at 164.

26       <sup>61</sup> SUF128.

27       <sup>62</sup> Davidson Ex. 311 at 252.

28       <sup>63</sup> SUF168-170.

<sup>64</sup> *Id.*

1 boxes (i.e., wood frames with one or more layers of fire-rated drywall) for each  
2 recessed lighting fixture ....”<sup>65</sup>

3 ELCO recognized the value of the invention as well. It [REDACTED]

4 [REDACTED]  
5 [REDACTED]”<sup>66</sup> [REDACTED]

6 [REDACTED]  
7 [REDACTED].<sup>67</sup> The copying was so complete that ECO’s Product  
8 Manager could only identify a few trivial differences between the products and  
9 admitted that [REDACTED]

10 [REDACTED].<sup>68</sup> ELCO’s blatant copying is manifest based on a  
11 comparison of the products’ outside appearance and internal arrangement of  
12 components.<sup>69</sup>

13 ELCO’s copying was noted by the Court in its preliminary injunction order,  
14 which included a comparison of the ‘266 Patent’s preferred embodiment, DMF’s  
15 DRD2 Module, and ELCO’s ELL Module.<sup>70</sup> ELCO’s expert, however, did not  
16 mention or consider objective evidence of nonobviousness when he submitted his  
17 report on invalidity, including industry praise for DMF’s DRD2 product that  
18 practices the patented invention and ELCO’s copying of the product.<sup>71</sup> Instead of  
19 considering this evidence to guide against hindsight analysis, Dr. Bretschneider  
20 embraced hindsight by impermissibly using the patent as a roadmap to identify  
21  
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23 <sup>65</sup> *Id.*

24 <sup>66</sup> SUF176.

25 <sup>67</sup> SUF187.

26 <sup>68</sup> SUF188..

27 <sup>69</sup> SUF195; Benya Dec., p. 80.

28 <sup>70</sup> Dkt. 147 at 4.

<sup>71</sup> Benya Decl., ¶365.

pieces of prior art and repurposing them to do what the inventor had done.<sup>72</sup> Having failed to consider real-world evidence that is “often be the most probative and cogent evidence in the record”<sup>73</sup> Dr. Bretschneider’s opinions on the issue of obviousness are unhelpful and unreliable.

The accompanying Statement of Undisputed Facts show that there is no genuine dispute of material fact that the asserted patent claims are not obvious based on the asserted prior art and the opinions of ELCO’s expert. *See* SUF 119-167.:

- Ground 1: Anticipation By Imtra Hatteras (SUF 94-100)
- Ground 2: Anticipation by Imtra 2011 (SUF 101-117)
- Ground 3: Obviousness Based on Imtra Hatteras and Imtra 2007 (SUF 119-123)
- Ground 4: Obviousness Based on Imtra 2011 and Imtra 2007 (SUF 124-126)
- Ground 5: Obviousness Based on Imtra 2011, Imtra 2007 and Gifford (SUF 127-143)
- Ground 6: Obviousness Based on Imtra 2011, Imtra 2007, Imtra Hatteras and Gifford (SUF 144)
- Ground 7: Obviousness Based on Kim and Gifford (SUF 145-152)
- Ground 9: Obviousness Based on Kim, Gifford and Chang (SUF 153)
- Ground 10: Obviousness Based on Imtra 2011, Hatteras and Kim (SUF 154-158)
- Ground 11: Obviousness Based on LMH2, Gifford and Imtra (SUF 159-167)

## **V. ELCO’s Unclean Hands Defense Fails As A Matter Of Law**

ELCO’s unclean hands defense is based on a pedantic disagreement about the right way to describe junction boxes certified by the non-governmental private company Underwriters Laboratory (“UL”). ELCO alleges that:

DMF falsely represented that its junction boxes to be used with the DRD2 [LED] module were fire rated up to 2 hours under UL Std. 514A, and the junction boxes constituted recessed lights, which require certification under UL Std. 1598.<sup>74</sup>

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<sup>72</sup> Davidson Ex. 491, ¶139 (“A [person of ordinary skill in the art] would thus understand that Gifford’s adaptor apparatus is equivalent to the casting of the ‘266 patent.”)

<sup>73</sup> *Id.*

<sup>74</sup> Dkt. 235 (Third Amended Answer) at 16:1-4.



ELCO's unclean defense fails based on undisputed facts because: (1) UL told DMF to use the 2-hr fire rated phrase; (2) *ELCO* used the same phrase to market its knockoff because building codes allowed it; (4) other companies used the same phrase; and (5) DMF junction boxes are "recessed lights" and even certified as such.

Moreover, ELCO's allegations don't support unclean hands because they have no "immediate and necessary relation" to how DMF obtained or enforced its patent.

#### **A. Procedural History**

ELCO first raised its unclean hands defense in opposing DMF's preliminary injunction motion.<sup>75</sup> The Court found ELCO's argument "misplaced as it bears no relevance to ELCO's alleged infringement of the '266 Patent."<sup>76</sup> Later, in response to DMF's motion to dismiss,<sup>77</sup> the Court found that "the sufficiency of defendants' unclean hands defense is better decided on a motion for summary judgment."<sup>78</sup>

#### **B. Unclean Hands Standard**

Unclean hands is an equitable defense requiring clear and convincing evidence that plaintiff engaged in "unconscionable" conduct that had an "immediate and necessary relation" to the equity that plaintiff seeks.<sup>79</sup> The defense stems from three Supreme Court cases concerning egregious misconduct in procuring or enforcing a patent. In *Keystone*, the patentee fabricated and suppressed evidence regarding the validity of its patent—it paid a witness to sign a false affidavit to defeat an invalidity defense using a "cover-up" that led to an injunction being granted before "the corrupt transaction between the patentee and the prior user" was discovered.<sup>80</sup>

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<sup>75</sup> Dkt. 53-2 at 15-16. ELCO raised a different unclean hands defense in its original Answer (Dkt. 15 at p. 17) but dismissed it to avoid a motion to dismiss. See Declaration of Ben M. Davidson, Exhibit 481.

<sup>76</sup> Dkt. 147 at 27.

<sup>77</sup> Dkt. 160 at 16-17; Dkt. 168 at 4.

<sup>78</sup> Dkt. 183 at 2.

<sup>79</sup> *Keystone Driller Co. v. General Excavator Co.*, 290 U.S. 240, 245.

<sup>80</sup> *Keystone*, 290 U.S. at 243.

1        *Hazel-Atlas* similarly involved the patentee falsifying and suppressing  
2 evidence on patent validity.<sup>81</sup> Faced with “insurmountable Patent Office  
3 opposition,” the patentee’s attorneys ghost wrote an article describing the invention  
4 as a technological advancement, had a famous expert sign and publish the article in  
5 his own name, and submitted the fabricated article to the Patent Office, which issued  
6 the patent. Later, when it asserted the patent in an infringement action, the patentee  
7 concealed the expert’s false authorship and paid him \$8,000 to cover up the fraud.<sup>82</sup>

8        *Precision Instruments* likewise involved a patentee suppressing evidence of  
9 perjury concerning patent validity before the Patent Office. The perjury involved  
10 false dates proving inventorship and false testimony in an interference proceeding  
11 that led to the patent issuing. A company that bought the patent knowing it was  
12 “tainted with perjury” was barred by its unclean hands from enforcing the patent.<sup>83</sup>

13        The egregious conduct and close nexus to the patent right in *Keystone*,  
14 *Hazeltine*, and *Precision Instruments* continue to represent what is required to show  
15 unclean hands. For example, the Federal Circuit recently upheld an unclean hands  
16 defense because a company patented its competitor’s invention after learning about  
17 the competitor’s files in violation of a “firewall” agreement.<sup>84</sup> This misconduct fit  
18 the requirement that the “‘misconduct’ of a party seeking relief ‘has immediate and  
19 necessary relation to the equity that he seeks in respect of the matter in litigation,’  
20 *i.e.*, ‘for such violations of conscience as in some measure affect the equitable  
21 relations between the parties in respect of something brought before the court.’”<sup>85</sup>

22        Misconduct in the abstract, unrelated to the claim to which it is asserted, does  
23 not constitute unclean hands because the issue is not whether “the plaintiff’s hands

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24        <sup>81</sup> *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238, 240-41 (1944).

25        <sup>82</sup> *Id.* at 240-41.

26        <sup>83</sup> *Precision Instr. Mfg v. Automotive Maintenance Mach.*, 324 U.S. 806 (1945).

27        <sup>84</sup> *Gilead Scis., Inc. v. Merck & Co.*, 888 F.3d 1231, 1239 (Fed. Cir.  
28        2018) (quoting *Keystone*, 290 U.S. at 245).

28        <sup>85</sup> *Id.*

are dirty, but that he dirtied them in acquiring the right he now seeks to assert, or that the manner of dirtying renders inequitable the assertion of such rights against the defendant.”<sup>86</sup> As held in *Keystone*, “courts of equity do not make the quality of suitors the test; [t]hey apply the maxim requiring clean hands only where some **unconscionable act** of one coming for relief has immediate and necessary relation to the equity that he seeks **in respect of the matter in litigation.**”<sup>87</sup>

**C. There Was No *Unconscionable Act***

ELCO cannot establish that DMF engaged in any unconscionable, deceptive advertising because ELCO *itself* used the phrase “certified UL514A up to 2 hr fire rating” when it copied DMF’s product. ELCO *admitted* in its Second Amended Answer that Exhibit 19 of the Complaint is ELCO marketing material promoting the ELCO junction box—a product that ELCO had copied from DMF (DMF and ELCO’s junction boxes are shown in the Complaint images below):<sup>88</sup>



That ELCO marketing material used the same phrase “**Metallic outlet box certified UL514A up to 2 hour fire rating**”<sup>89</sup> that DMF used for its UL514A-certified box.

<sup>86</sup> *Id.*

<sup>87</sup> *Keystone*, 290 U.S. at 245 (emphasis added).

<sup>88</sup> Complaint (Dkt. 1) at ¶¶82, 83, Exs. 19 and 20; Second Amended Answer (Dkt. 160) at ¶83. *Id.* See also SUF198-SUF223; SUF246; SUF247.

<sup>89</sup> SUF202; SUF203; SUF206; SUF207. SUF203..

1 This was industry short-hand for a product that *maintains* a ceiling's fire-rating.<sup>90</sup>  
2 Fire-rated ceilings are made of material that slows down how fast a fire can pass  
3 through a ceiling to the room above it. If a hole is cut into a fire-rated ceiling, a fire  
4 in the room below can spread through that hole. Metallic boxes commonly called  
5 "fire-rated" allow an **already fire-rated ceiling** to maintain its rating.<sup>91</sup>

6 ELCO cannot distinguish its own use of the UL514A standard from DMF's  
7 because it withheld documents on the issue.<sup>92</sup> The parties jointly filed a motion on  
8 ELCO's "object[ion] to producing information regarding its understanding that its  
9 metallic junction box housings complied with UL Standards 514A and 1598 [and  
10 on] ELCO's position ... that its own use and understanding of these standards is not  
11 relevant to ELCO's unclean hands defense based on these same UL Standards."<sup>93</sup>  
12 Magistrate Judge Standish ordered ELCO to produce these documents,<sup>94</sup> explaining,  
13 "[y]ou can't accuse somebody of having 'unclean hands' and expect to be able to  
14 insulate yourself from discovery."<sup>95</sup> But ELCO did just that. Despite the Order,  
15 ELCO failed to produce the requested documents.<sup>96</sup> Under Rule 37, ELCO should  
16 not be permitted to distinguish its own understanding of the phrase from DMF's.<sup>97</sup>

17 Even the limited discovery that DMF was able to take established that DMF  
18 used its UL certification appropriately. [REDACTED]

21 <sup>90</sup> SUF209; SUF244..

22 <sup>91</sup> Danesh Decl., ¶¶8-9.

23 <sup>92</sup> Davidson Decl., ¶¶76-78.

24 <sup>93</sup> Davidson Decl., Ex. 482 (joint email motion to Magistrate Judge Standish).

25 <sup>94</sup> Dkt. 286 ("information sought related to 'UL Standards' is relevant and also  
must be provided.")

26 <sup>95</sup> Davidson Decl., Ex. 483 (10/16/2019 hearing transcript at 6-7).

27 <sup>96</sup> Davidson Decl., ¶¶76-78.

28 <sup>97</sup> Fed.R.Civ.P. 37(b)(a)(2) (permitting Court to issue order "prohibiting the  
disobedient party from supporting or opposing designated claims or defenses, or  
from introducing designated matters in evidence.")

1 [REDACTED]  
2 [REDACTED]  
3 [REDACTED]  
4 [REDACTED]  
5 [REDACTED]  
6 [REDACTED] <sup>101</sup>  
7 These undisputed facts are consistent with the testimony of DMF's Chief  
8 Operating Officer: (1) UL certified DMF's product under its 514A standard; (2) that  
9 514A standard came with UL guidance permitting "USE IN FIRE-RATED  
10 ASSEMBLIES" in "walls with ratings not exceeding 2h[ours]"; and (3) UL itself  
11 approved DMF's marketing language in June 2016.<sup>102</sup> DMF continued using this  
12 language for two years, when, shortly before the filing of this lawsuit, UL changed  
13 its fire rating guidance, after which DMF clarified that "Metallic outlet boxes with  
14 metallic or nonmetallic cover plates may be used in floor-ceiling and roof-ceiling  
15 assemblies with ratings not exceeding 2 hours."<sup>103</sup> [REDACTED]  
16 [REDACTED]  
17 [REDACTED].<sup>104</sup> That is,  
18 contrary to ELCO's admitted theory, DMF did not mislead the industry into  
19 believing "that its OneFrame system could be installed *in any ceiling*"<sup>105</sup> or "even  
20  
21

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22 <sup>98</sup> SUF210.

23 <sup>99</sup> SUF211.

24 <sup>100</sup> SUF211.

25 <sup>101</sup> SUF208. Danesh Decl., ¶¶5, 10-20.

26 <sup>102</sup> SUF328; Danesh Dec. ¶4.

27 <sup>103</sup> Danesh Dec. ¶20.

28 <sup>104</sup> *Id.*.

<sup>105</sup> Dkt. 53-2 at 3:2-5 (preliminary injunction opposition); Dtk. 170-2, Ex. 1, p. 4 (email to ELCO's counsel confirming ELCO's theory of deceptive conduct).



one made out of card board.”<sup>106</sup> In addition, contrary to ELCO’s allegation, DMF did not retire its junction box in response to ELCO’s preliminary injunction opposition.<sup>107</sup>

ELCO is also wrong in alleging that DMF had no right to call its junction boxes “recessed lights” because it lacked “certification under UL Std. 1598.” These junction boxes are recessed lights because they are recessed behind a ceiling and, , though not necessary, are certified by UL under its 1598 standard.<sup>108</sup>

In sum, the record here does not come close to supporting that DMF committed an unconscionable act akin to procuring its patent by bribing witnesses to lie, suppressing patent validity information, or falsifying affidavits.

**D. DMF’s Marketing Phrases Have No “Immediate And Necessary Relation” To How It Obtained Or Enforced The ‘266 Patent.**

ELCO’s allegations also fail as a matter of law because they lack an “immediate and necessary” relation to the equity that it seeks in respect of the matter in litigation. Unclean hands in patent cases typically arise only where there has been serious misconduct related to procurement or enforcement of the patent.<sup>109</sup> Allegations about deceptive marketing by the patentee lack the required close nexus to how the patent was obtained. In *Gabapentin*,<sup>110</sup> for example, defendants alleged unclean hands based on the patentee’s scheme to “aggressively and illegally promote [the drug] Neurontin for a variety of unapproved uses, without seeking FDA approval, in order to inflate market share and profits.” Up to 94% of the patentee’s

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<sup>106</sup> Davidson Decl., Ex. A (meet and confer letter) at 4; Dkt. 53-2 (preliminary injunction opposition) at 15 (“DMF essentially represented that its OneFrame system could be installed *in any ceiling*, when in fact those components must be installed in a fire-rated ceiling to pass fire resistance requirements.”)(emphasis added).

<sup>107</sup> SUF 226.

<sup>108</sup> SUF 245.

<sup>109</sup> *In re Gabapentin Patent Litig.*, 648 F. Supp. 2d 641, 650-51 (D.N.J. 2009) (collecting and summarizing cases).

<sup>110</sup> *Id.*



1 sales were from illegal, off-label uses, creating an illegally acquired market share  
2 that the patentee continued to exploit.<sup>111</sup> Even assuming as true the serious *criminal*  
3 allegations, the court struck the defense because that misconduct did not give rise to  
4 or affect the patent rights that the patent owner was seeking to enforce. Similarly, in  
5 *CIBA-Geigy*, mislabeling of a drug and sales of adulterated drug batches were too  
6 attenuated from plaintiff's trademark claims to support an unclean hands defense.<sup>112</sup>

7 Here, as in these cases, unclean hands is not a valid defense because the  
8 phrases used by DMF has no nexus to how it obtained or enforced its patent.

9 **E. ELCO's Allegations Provide No Defense To Its Trademark**  
10 **Infringement And Unfair Competition**

11 The Court also should dismiss ELCO's unexplained pursuit of unclean hands  
12 as a defense to trademark and unfair competition. DMF alleges that ELCO created a  
13 likelihood of confusion by copying DMF's trims sold under the OneLED and  
14 OneFrame marks and selling them under the name UNO.<sup>113</sup> ELCO has not even  
15 alleged let alone shown that DMF obtained its marks through fraud or that it used  
16 them to deceive consumers. This is fatal to ELCO's defense because the Ninth  
17 Circuit has significantly narrowed the unclean hands defense<sup>114</sup> and requires proof  
18 that the "plaintiff used the trademark to deceive consumers."<sup>115</sup> Where, as here, the  
19 alleged misconduct did not have an "immediate and necessary relation" to the  
20 manner in which the plaintiff acquired its rights, the defense is unavailable.<sup>116</sup> Thus,

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21 <sup>111</sup> *Id.* at 648-49.

22 <sup>112</sup> *CIBA-Geigy Corp. v. Bolar Pharm. Co.*, 747 F.2d 844, 855 (3d Cir. 1984).

23 <sup>113</sup> Dkt. 1 at 42-49.

24 <sup>114</sup> *2die4kourt v. Hillair Capital Mgmt., LLC*, No. SACV 16-01304 JVS(DFMx),  
2016 U.S. Dist. LEXIS 118211, at \*25 (C.D. Cal. Aug. 23, 2016)(citing  
25 *See Cochran Firm, P.C. v. Cochran Firm L.A. LLP*, 641 Fed. Appx. 749, 751 (9th  
26 Cir. 2016) (unpublished)).

27 <sup>115</sup> *Perfumbay.com Inc. v. eBay Inc.*, 506 F.3d 1165, 1177 (9th Cir. 2007).

28 <sup>116</sup> *S. Cal. Darts Ass'n v. Zaffina*, 762 F.3d 921, 932-33 (9th Cir. 2014). *See also*  
*Abbott Labs. v. Adelphia Supply United States*, No. 15-CV-5826 (CBA) (LB), 2019  
U.S. Dist. LEXIS 194268, at \*64 (E.D.N.Y. Sep. 27, 2019)("In trademark  
infringement suits, courts typically require that the unconscionable conduct relate to  
the plaintiff's acquisition of the trademark rights at issue.")

1 in *Fuddruckers*, the Ninth Circuit held that a hamburger chain could protect its trade  
2 dress from infringement notwithstanding its alleged deceptive advertising of its  
3 hamburgers as “ground steak” because that was not a material element of the  
4 hamburger chain’s trade dress and was not “fraud or deceit *as to the controversy in*  
5 *issue.*”<sup>117</sup> Likewise, here, alleged inaccuracies in describing a junction box do not  
6 make DMF’s trademark claims unenforceable.

7  
8 Dated: February 3, 2020

Respectfully submitted,

9 by: /s/ David W. Long

10 David W. Long (admitted *pro hac vice*)  
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<sup>117</sup> *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 847 (9th Cir. 1987)(emphasis added).